

REMARKS

Claims 29-40, 47-61, 68-162 remain in this application. Claims 1-28, 41-46, and 62-67 have been previously cancelled. Claims 86-162 are new.

In response to the Election/Restriction Requirement contained in the Office Action mailed December 8, 2003, Applicant agrees that four species identified by the examiner are patentably distinct. Applicant elects to prosecute the claims 29-34, 40, 47-61 and 68, which the office action categorizes as Invention I ("Claims 29-34, 40, 47-61 and 68, drawn to currency evaluation with means for flagging a bill").

However, Applicant does not agree with any characterization based on the loose language of the outstanding Office Action that the claims identified in Groups I-IV recite "means for" or otherwise contain limitations under 35 U.S.C. §112, ¶6. While some limitations of some claims recite "means for," (see *e.g.*, claim 29: "means for flagging a bill when the denomination of said bill is not determined by said discriminating unit"), other claims do not (see, *e.g.*, claim 69: "a flagging device" and claim 84: "a diverter"). Only those limitations expressly reciting the words "means for" or "step for" are limitations under 35 U.S.C. §112, ¶6. All other limitations do not fall within 35 U.S.C. §112, ¶6.

Comments Regarding Old Claims

For the Examiner's benefit it is pointed out that:

Claims 48-54 and 59-61 have been grouped into Group I. Claim 48 recites, *inter alia*, "wherein the act of flagging a bill comprises the act of halting the transporting of the bills." Claims 49-54 are directly or indirectly dependent thereon. Claim 59 recites "wherein the act of flagging comprises the act of halting the transporting of bills." Claims 60-61 are dependent thereon.

Claims 69-73 have been grouped into Group III. Claim 69 recites, *inter alia*, "wherein the processor ... is programmed to cause the transport mechanism to halt when the denomination of a bill is not determined by the processor." Claims 70-73 are dependent on claim 69.

Claims 76-83 has been grouped into Group II. Claim 76 is independent and claims 77-83 are dependent, directly or indirectly, thereon. Independent claim 76, however, does not recite either an “act of flagging” limitation or an “act of halting” limitation. Dependent claims 77 and 78 do not recite an “act of halting” limitation. Claim 78 recites “wherein the act of flagging comprises the act of diverting a bill whose denomination is not determined to a stacker bin separate from the denominated bill output receptacle.” Accordingly, Applicant respectfully requests reconsideration of the grouping of claims 76-78 into Group II and requests instructions from the Examiner as to how these claims should be grouped. It is also pointed out that the method claims, including dependent claims 79-83, do not recite or contain “means for” anything. Rather, for example, claim 79 recites “wherein the act of flagging comprises the act of halting...,” neither of which are limitations under 35 U.S.C. §112, ¶6.

Claim 75 which has been identified as belonging to Species III does not contain a flagging limitation. Accordingly, Applicant respectfully requests reconsideration of the grouping of claim 75 into Group III and requests instructions from the Examiner as to how this claim should be grouped.

Comments Regarding New Claims

Claim 86 is believed by applicant to belong to Group III.

Claims 87-106 are not believed by applicant to belong to any of Groups I-IV as these claims do not contain any flagging limitation. Applicant respectfully requests the Examiner’s guidance as to how these claims should be grouped, such as, for example, into a new Group V.

Claims 107-115 are method claims, which applicant believes the examiner would classify as belonging to Group I, based on the Office Action dated December 8, 2003. However, applicant notes for examiner that claim 107 does not contain a flagging limitation. A flagging limitation is present in claims 108 and 109, which depend either directly or indirectly on claim 107. Claims 110 and 111 do not contain a flagging limitation. A flagging limitation is present in claim 112, which depends on claim 111. Claim 113 contains a flagging limitation that involves

diverting. Claim 114 contains a flagging limitation that halts the transport. Claim 115 contains a flagging limitation that halts the transport at a predetermined location.

Claims 116-140 are believed by applicant to belong to Group IV.

Claims 141-162 are method claims, which applicant believes the Examiner would classify as belonging to Group I, based on the Office Action dated December 8, 2003. However, applicant notes for the Examiner that independent claims 141 and 152 do not contain a flagging limitation. A flagging limitation is present in claims 146-151 and claims 157-162, which depend either directly or indirectly on claims 141, and 152 respectively. Claims 142-145 and 153-156 do not contain a flagging limitation. Claims 147-151 and 159-162 contain a flagging limitation that involves halting the transport mechanism.

Applicants respectfully requests the Examiner's instruction and/or confirmation of the appropriate grouping of new claims 86-162.

Comments Regarding "Notes"

The Office Action also contains two "notes." The first note states "Since no figures are identified in the brief description of the drawings to be directed to the subject matter of the claims nor any alternative embodiments of same, applicant is required to identify the figures directed to each species and the corresponding locations in the specification of the instant invention and all of the parents where the species are supported." No MPEP or other citation is provided as the basis of this "note." Applicant is unaware of any requirement that the figures in the brief description be identified "to be directed to the subject matter of the claims [or] any alternative embodiments of same." Applicant is also confused by what the Examiner intends. Applicant is also unaware of any requirement that "the figures directed to each species and the corresponding locations in the specification of the instant invention and all of the parents where the species are supported" be identified. Applicant is confused by this language. Accordingly, Applicant respectfully requests the Examiner to identify the section(s) of the MPEP with which the Examiner is requesting the Applicant to comply. Doing so will assist the Applicant's ability to properly respond.

In general, however, Applicant respectfully believes that a review of the entire application may be helpful in understanding the present application.

The present application is a continuation of Application No. 09/837,500, now U.S. Pat. No. 6,378,683, and accordingly the specification is generally the same as the specification of the present application. Application No. 09/837,500 was a continuation of Application No. 08/834,746, now U.S. Pat. No. 6,220,419, accordingly the specification is generally the same as the present application. Figures 1-49 of the present application are generally the same or identical to Figures 1-49 of Application Nos. 09/837,500 and 08/834,746.

The second "note" states "Since the contents of the instant application was obviously developed to support a number of applications, applicant is requested to withdraw the citation of documents that are not directed to the specific subject matter of the instant application." No MPEP or other citation is provided as the basis of this "note". Applicant is confused by what the Examiner intends. Accordingly, Applicant respectfully requests the Examiner to identify the section(s) of the MPEP with which the Examiner is requesting the Applicant to comply. Doing so will assist the Applicant's ability to properly respond.

In general, however, the applicant notes that the Federal Circuit has stated "[t]o avoid a finding of inequitable conduct, doubts concerning whether information is material should be resolved in favor of disclosure." *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp.*, 267 F.3d 1370, 1380 (Fed. Cir. 2001).

It is generally noted that the references submitted in the IDS for the current application are generally the same as the references submitted in Application No. 09/837,500. Applicant also believes that the subject matter of the claims in the current application is similar to the subject matter of the claims in Application No. 09/837,500. More specifically, references A1-A137 submitted in connection with the present application correspond to references A1-A137 of the '500 application. References B1-B36 submitted in connection with the present application correspond to references B1-B36 submitted in the '500 application. References C1-C53 submitted in the present application correspond to references C1-C53 submitted in the '500 application. References C54-C60 submitted in connection with the present application correspond to references E1-E7 submitted in the '500 application.

References E1-E80 of the present application are newly cited references. References E1-E80 were submitted in Application No. 10/163,757 and/or Application No. 10/434,659, which

have the same assignee as the present application and also relate to currency discrimination. References E73-E80 are patents that were cited in the '757 and/or '659 applications by their publication numbers and have since issued.

References F1-F17 of the present application are newly cited references. References F1-F17 were submitted in Application No. 10/163,757 and/or Application No. 10/434,659, which have the same assignee as the present application and also relate to currency discrimination.

On October 1, 2002, Cummins-Allison Corp., assignee of the present application, sued Glory Ltd., Glory Shoji Co. Ltd., and Glory (U.S.A.), Inc., in the United States District Court for the Northern District of Illinois, Civil Action No. 02C-7008 (complaint listed as ref. G1) for infringement concerning U.S. Pat. No. 6,459,806. The documents listed on the attached Form PTO-1449 as refs. G1-G94 are from this litigation. Accordingly, pursuant to 37 C.F.R. §1.98(3)(i), the relevance of any non-English references listed on the attached Form PTO-1449 from G1-G94 is that such references were identified by Glory in the above mentioned litigation. On June 13, 2003, an amended complaint was filed by Cummins-Allison Corp. in the above mentioned litigation (amended complaint listed as ref. G95) that added infringement concerning U.S. Pat. No. 5,295,196 to the litigation.

References G96-G138 of the present application are newly cited references. References G96-G138 were submitted in Application No. 10/163,757 and/or Application No. 10/434,659, which have the same assignee as the present application and also relate to currency discrimination.

The second note further states "Also applicant is requested per page 600-123, column 1, paragraph 3 of the MPEP to direct examiner to the specific column and line as well as figures that are relevant to the examination of the elected species." Applicant respectfully points out that the MPEP states "a concise explanation is not required for English language information." MPEP, 600-123, column 1, paragraph 3. Additionally, the Federal Circuit has held that "statements made in an IDS can be the basis for a court to interpret the scope of the claims of a granted patent." *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1303-04 (Fed. Cir. 1997). Further, inequitable conduct is charged so frequently that the Federal Circuit has stated "the habit of charging inequitable conduct in almost every major patent case has become an absolute plague." *Burlington Indus., Inc. v. Dayco Corp.*, 849 F.2d 1418, 1422 (Fed. Cir. 1988). This

"habit" seems no less prevailing today than when the Federal Circuit initially made this statement. One basis for a charge of inequitable conduct is failing to disclose material information to the patent office with an intent to deceive. *Kingsdown Medical Consultants Ltd. v. Hollister, Inc.*, 863 F.2d 867, 872 (Fed. Cir. 1988). Applicant's "good faith" does not preclude a charge of inequitable conduct from being brought. *Argus Chem. Corp. v. Fibre Glass-Evercoat, Inc.*, 759 F.2d 10, 14-15 (Fed. Cir. 1985). Based on the state of the law, it appears that any statement applicant could make can and would be used against it in a later proceeding involving any patent that may issue from this application, either to allege inequitable conduct, or to limit the scope of the claims. Therefore, it would be ill-advised for applicant to make any statement that is not required.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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